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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/833,986	04/12/2001	Yong Chang	678-649 (P9792)	2092
28249	7590	11/28/2005	EXAMINER	
DILWORTH & BARRESE, LLP 333 EARLE OVINGTON BLVD. UNIONDALE, NY 11553			FOX, JAMAL A	
			ART UNIT	PAPER NUMBER
			2664	

DATE MAILED: 11/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/833,986

Applicant(s)

CHANG, YONG

Examiner

Jamal A. Fox

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 September 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 4-7 is/are allowed.
- 6) ☒ Claim(s) 1-3 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 04 May 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☒ Certified copies of the priority documents have been received in Application No. 09/833,986.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date. _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Krishnamurthi et al. (U.S. Patent No. 6,134,434) in view of Krishnamurthi et al. (U.S. Patent No. 6,198,929).

Referring to claim 1, Krishnamurthi et al. (U.S. Patent No. 6,134,434) discloses a method for performing a handoff (handoff, col. 9 line 55 - col. 10 line 6) including a first base station (BS1 108, col. 9 line 55 - col. 10 line 6) communicating voice and packet data (voice, data, col. 3 lines 9-18) with a mobile station (SU1 112, col. 9 line 55 - col. 10 line 6), a mobile switching center (MSC 102, col. 9 line 55 - col. 10 line 6) connected to the first base station (BS1, Figures 3 and 4) and a second base station (BS2 110, col. 9 line 55 - col. 10 line 6) adjacent to the first base station (BS1, Figures 3 and 4), the method comprising the steps of:

sending (sends, col. 9 lines 57-58) a handoff required message from the first base station to the mobile switching center, the handoff required message including a service configuration record (service configuration, col. 9 lines 57-60);

sending (sends, col. 9 lines 60-62) from the mobile switching center the service configuration record of the received handoff required message to the second base station;

determining (processing, col. 9 lines 62-64) in the second base station whether it is possible to communicate with the mobile station using a radio resource specified in the service type identifier and the service configuration record, sending, when it is not possible to communicate with the mobile station, to the mobile switching center a new service type identifier and a new service configuration record indicating that communicating with one of the voice and packet data with the mobile station is possible;

sending (returns, col. 9 lines 64-66) from the mobile switching center the new service type identifier and the new service configuration record to the first base station; but does not explicitly teach of including a service type identifier indicating a concurrent service of the voice and packet data, sending from the first base station the new service type identifier and forming in the mobile station a communication link (link, col. 5 lines 36-48) to the second base station according to the new service configuration record. However, voice and packet data are disclosed in Krishnamurthi et al. (U.S. Patent No. 6,198,929) (voice and SMS messages, col. 2 lines 55-59, col. 3 lines 15-34, col. 7 lines 49-58, col. 8 lines 8-17, col. 8 lines 36-53, col. 8 line 65-col. 9 line 8, col. 9 lines 10-23, col. 9 line 66-col. 10 line 16 and col. 11 lines 10-22), and the Service Configuration Directive contains the service configuration. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have included the service type identifier indicating a concurrent service of the voice and packet data of

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Krishnamurthi et al. (U.S. Patent No. 6,198,929) to the invention of Krishnamurthi et al. (U.S. Patent No. 6,134,434), in order to maintain the service connection by allowing both calls as suggested by Krishnamurthi et al. (U.S. Patent No. 6,198,929).

Referring to claim 2, Krishnamurthi et al. discloses the method of claim 1, but does not explicitly teach of the service configuration record comprising resource information including a radio channel. However, radio frequency communication is disclosed in (col. 5 lines 19-22). Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to have included the service configuration record comprising resource information including a radio channel in order to provide two way communication between the base stations and the mobile station as suggested by Krishnamurthi et al.

Referring to claim 3, Krishnamurthi et al. discloses the method of claim 1, wherein the service configuration record comprises resource information including a data rate (data rate, col. 7 lines 43-44).

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical

Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

4. Claims 1-3 are rejected under 35 U.S.C. 102(e) as being anticipated by Krishnamurthi et al. (U.S. Patent No. 6,198,929).

Referring to claim 1, Krishnamurthi et al. discloses a method for performing a handoff (handoff col. 9 line 52-col. 10 line 16) on a voice and data packet (voice and SMS messages, col. 2 lines 55-59, col. 3 lines 15-34, col. 7 lines 49-58, col. 8 lines 8-17, col. 8 lines 36-53, col. 8 line 65-col. 9 line 8, col. 9 lines 10-23, col. 9 line 66-col. 10 line 16 and col. 11 lines 10-22) in a mobile communication system (Figures 1, 2 and 4) including a first base station (Figures 1-5 BS1, ref. sign 108 and respective portions of the spec.) communicating voice and packet data (voice and SMS messages, col. 2 lines 55-59, col. 3 lines 15-34, col. 7 lines 49-58, col. 8 lines 8-17, col. 8 lines 36-53, col. 8 line 65-col. 9 line 8, col. 9 lines 10-23, col. 9 line 66-col. 10 line 16 and col. 11 lines 10-22) with a mobile station (Figures 1-3, SU1, ref. sign 112 and respective portions of the spec.), a mobile station switching center (Figures 1-5, MSC, ref. sign 102 and respective portions of the spec.) connected to the first base station (Figures 1-5 BS1, ref. sign 108 and respective portions of the spec.), and a second base station (Figures 1-3, BS2 ref. sign 110 and respective portions of the spec.) adjacent to the first base station, the method comprising the steps of:

sending a handoff required message (message, col. 9 lines 24-50) from the first base station to the mobile switching center, the handoff required message including a service type identifier indicating a concurrent service of the voice and packet data and a service configuration record;

sending from the mobile switching center (MSC 102, col. 8 lines 35-53) the service type identifier and the service configuration record of the received handoff required message to the second base station;

determining (processing, col. 10 lines 1-16) in the second base station whether it is possible to communicate with the mobile station using a radio resource specified in the service type identifier and the service configuration record, and sending, when it is not possible to communicate with the mobile station, to the mobile switching center a new service type identifier and a new configuration record indicating that communicating with one of the voice and packet data with the mobile station is possible;

sending from the mobile switching center (MSC 102, col. 10 lines 7-12) the new service type identifier and the new service configuration record to the first base station (BS1 108, col. 10 lines 7-12) and sending from the first base station the new service type identifier and the new service configuration record to the mobile station (SU1 112, col. 10 lines 12-16); and

forming in the mobile station a communication link to the second base station according to the new service type identifier and the new (new, col. 10 lines 13-16) service configuration record.

Referring to claim 2, Krishnamurthi et al. discloses the method of claim 1, wherein the service configuration record comprises resource information including a radio channel (radio, col. 5 lines 1-8 and channel, col. 6 lines 34-52).

Referring to claim 3, Krishnamurthi et al. discloses the method of claim 1, wherein the service configuration record comprises resource information including a data rate (transmission rate, col. 6 lines 38-43).

Allowable Subject Matter

5. Claims 4-7 are allowed.

Response to Arguments

6. Applicant's arguments filed 9/16/2005 have been fully considered but they are not persuasive. Applicant argued that Krishnamurthi '434 does not include radio resource information such as a channel assigned to a base station transceiver and a data rate. Applicant also argued that Krishnamurthi '434 fails to disclose the service type identifier disclosed in the claims of the present application. However, one skilled in the art would recognize that radio resource information which is the SMS message and a service type identifier, which is part of the configuration record, are both disclosed in Krishnamurthi '929 (col. 3 lines 9-55).

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Applicant argued that the service option of Krishnamurthi '929 is for an initiated negotiation between the mobile terminal and the base station, while the service option of the present invention is to indicate a concurrently provided service type. However, one skilled in the art would recognize that the service option of Krishnamurthi '929 is for a concurrently provided service type because the voice and SMS call are multiplexed (see col. 3 lines 10-25).

Conclusion

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

8. **Any response to this final action should be mailed to:**

Box AF

Commissioner of Patents and Trademarks
Washington, D.C. 20231

or faxed to:

(571) 273-8300, (for formal communications intended for entry)

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9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jamal A. Fox whose telephone number is (571) 272-3143. The examiner can normally be reached on 6:30 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wellington Chin can be reached on (571) 272-3134. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to 2600 Customer Service whose telephone number is (571) 272-2600.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jamal A. Fox



WELLINGTON CHIN
SUPERVISORY PATENT EXAMINER